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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,792	11/12/2003	Robert Gerald Kushner	50065.00008	7797

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EXAMINER

MORGAN JR, JACK HOSMER

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,792	Applicant(s) KUSHNER, ROBERT GERALD	
	Examiner Jack H. Morgan	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/12/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species: (Fig 1-4) a tool embodied as a calculator, (Fig 5) a tool embodied as a writing surface, (Fig 6) a tool embodied as a screwdriver and writing utensil and (Fig 7) a tool embodied as an eyeglass cleaning kit. The species are independent or distinct because the application claims an article holder with a tool. In addition the application also claims four significantly different types of tools. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 9 are the generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a) During a telephone conversation with Stuart Whittington on August 1, 2006 a provisional election was made with traverse to prosecute the invention of the species involving the calculator, claims 1, 2, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 17. Claim 12, which includes a Markush group, will only be examined with respect to the elected species. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4 and 5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

3. The use of the trademarks POST-IT® and VELCRO® have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the various attachment methods of the device, including the segment of double-sided tape, the magnet, the hook and the segment of hook and loop fastener material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 7 is objected to because of the following informalities: There is no period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 16 contains the trademark/trade name VELCRO®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any

particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a hook and loop closure system and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (US 5,180,133). Chang discloses a clipboard comprising a clamping body (fig 4) having a clamping position and an open position and comprising an upper arm (10); a lower arm (20) pivotally connected at one end thereof to a corresponding end of the upper arm such that personal articles may be retained between the upper and lower arms, said clamping body also having a cavity formed therein (101). Chang also discloses an attachment means (the hole in 30) connected to the clamping body for attaching the clamping body to a desired surface.

Regarding claim 2 Chang discloses a calculator (60) to be removably inserted into the cavity (101).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 6, 7, 9, 10, 11, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180,133).

Ainley et al. disclose a spectacles caddy comprising a comprising a clamping body (fig 1) having a clamping position and an open position and comprising an upper arm (3); a lower arm (2) pivotally connected at one end thereof to a corresponding end of the upper arm such that personal articles may be retained between the upper and lower arms, said clamping body also having a cavity formed therein (un-numbered recess in the top middle face of 3, seen clearly to be a recess again in figure 4, where the 1 is pointing to). Ainley et al. also disclose an attachment means (5) connected to the clamping body. However, Ainley et al. fail to disclose a tool operative to be removably inserted into the cavity. Chang discloses a calculator (Fig 4, 60) to be removably inserted into a cavity. Mounting the calculator allows it to be used with one hand. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able

to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator.

In regards to claim 6, Ainley et al. disclose a clamping body with a cushion member on each arm (Col 4, lines 2-4).

In regards to claim 7, Ainley et al. disclose an attachment means comprising a clip (fig 1, 4 or col 2, line 49).

In regards to claim 9, Ainley et al. disclose a holder for securing objects where the cushions face one another (fig 1, 19, 18); the cavity of the top arm (un-numbered recess in the top middle face of 3, seen clearly to be a recess again in figure 4, where the 1 is pointing to) being on the opposite side of the top arm (3) to the cushion (19) and the attachment portion (4) being disposed on the surface of the lower arm (2) opposite the lower arm's cushion member (18). As stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator.

In regards to claim 10, Ainley et al. disclose the two arms of the design being composed of injection-molded plastic (Col 3, line 63-64).

In regards to claim 11, as stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator.

In regards to claim 14, Ainley et al. disclose an attachment portion comprising a clip (fig 1, 4 or col 2, line 49).

In regards to claim 17, as stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,180,133) in view of Leung (US 6,178,085).

Chang discloses all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a second position to support the calculator in a substantially upright position. Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the calculator of Chang with the rotating cover of Leung in order to provide protection for the keypad and display of the calculator and also allow it to be removed from the stand and propped up on a desktop.

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10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Leung (US 6,178,085).

Ainley et al., as modified above, disclose all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a second position to support the calculator in a substantially upright position. Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with the rotating cover taught by Leung in place of the basic calculator in order to provide protection for the keypad and display of the calculator and also allow it to be removed from the stand and propped up on a desktop.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Chimel (US 5,653,414).

Ainley et al., as modified above, disclose all the limitations of the claim except for an attachment portion comprising of a segment of double sided tape. Chimel discloses

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an eyeglass clip (fig 1, 10) that is attached to a surface using double sided tape (fig 1, 34; Col 2, lines 58-59) for mounting the clip to a surface in a vehicle or other convenient surface (Col 2, lines 60-61). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with double sided tape as taught by Chimel in place of the attachment means (5) of Ainley et al. as a mere substitute of known means to attach clips.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Horovitz (US 6,260,749).

Ainley et al., as modified above, disclose all the limitations of the claim except for an attachment portion comprising of a magnet. Horovitz discloses an eyeglass holder (fig 3, 11) that is attached to a surface using a magnet (Fig 3, 19; Col 11, lines 13-14) for mounting the holder to an article of clothing or other thin surface (Col 9-10, lines 66-4). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with a magenet as taught by Horovitz in place of the attachment means (5) of Ainley et al. as a mere substitute of known means to attach clips.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Lee (US 2002/0010983 A1)

Ainley et al., as modified above, disclose all the limitations of the claim except for an attachment portion comprising of a segment of a hook. Lee discloses an eyeglass clip (fig 1) that is attached to a surface using a hanger (fig 1, 3; page 2, para [0025]) for hanging the eyeglass clip onto another object. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with a hanger as taught by Lee in place of the attachment means (5) of Ainley et al. as a mere substitute of known means to attach clips.

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Tuber (US 5,312,029).

Ainley et al., as modified above, disclose all the limitations of the claim except for an attachment portion comprising of a segment of hook and loop fastener material. Tuber discloses an eyeglass case (fig 2, 10) that is attached to a surface using hook and loop fastener material (fig 10, 6; Col 4, lines 56-63) for ready mounting and removal of the case to another hook and loop fastener surface. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with hook and loop fastener material as taught by Tuber in place of the attachment means (5) of Ainley et al. as a mere substitute of known means to attach clips.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Cornell et al. (US 5,413,382), Chan (US 6,210,003), and Loh et al. (US 5,530,234).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack H. Morgan whose telephone number is 571-272-3385. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHM

Jack Morgan
Art Unit 3727
August 14, 2006


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